UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/774,795	02/01/2001	Travis Parry	10003180-1	2625

7590   07/11/2005

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER
BULLOCK JR, LEWIS ALEXANDER

ART UNIT	PAPER NUMBER
2195	

DATE MAILED: 07/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Office Action Summary	Application No.	Applicant(s)
		09/774,795	PARRY, TRAVIS
		Examiner	Art Unit
		Lewis A. Bullock, Jr.	2195

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _15 June 2005_.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-20_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-20_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _01 February 2001_ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2.   Claims 1, 2, 5-9, 12-17, 19 and 20 are rejected under 35 U.S.C. 102(e) as being

anticipated by OKIMOTO (U.S. Patent 6,160,631).

As to claim 1, OKIMOTO teaches a computer program product, comprising: a

computer-readable medium containing instructions for controlling a computer system

(col. 6, lines 30-39; col. 7, lines 42-61; col. 39, lines 54 – col. 40, line 3) to perform a

method of delaying an initiation of an operation, the method comprising: requesting that

a user input a delay criteria (date and time) before the initiation of the operation (via the

operator inputting his/her instruction to print the document and inputting information in

subsequent windows, in particular the print mail transmission settings screen which

allows the operator to input settings for date and time when the print data is desired to

be printed at the destination) (col. 10, lines 6-14; col. 11, lines 3-14; col. 11, line 15 –

col. 12, line 15; col. 13, line 66 – col. 14, line 33); and delaying performance by the

computer system of the operation until the delay criteria has been met (col. 20, lines 30-

46; col. 6, lines 1-6); wherein the operation comprises at least one operation chosen

from the group consisting of a print command, an e-mailing distribution, as software

installation, a file transfer protocol upload, a web site posting and an internet phone call

(via a print mail command).

As to claim 2, OKIMOTO teaches the delay criteria is at least one chosen from

the group consisting of a time interval, a set time, and the occurrence of a particular

condition (date and time) (col. 14, lines 16-33).

As to claim 5, OKIMOTO teaches the operation comprises printing a document

(col. 8, lines 59-65; col. 10, lines 6-27; col. 11, lines 3-14).

As to claim 6, OKIMOTO teaches the delaying step comprises storing the

document in a job store (predetermined storage area / transmission log storage) (col.

10, lines 6-14; col. 11, lines 3-14; col. 11, line 15 – col. 12, line 15; col. 13, line 66 – col.

14, line 33).

As to claim 7, OKIMOTO teaches the job store comprises at least one item chose

from the group consisting of a printer memory, a personal computer memory, a spooler,

a local area network, a wide area network, and an internet storage location

(predetermined storage area / transmission log storage / transmitted over a network)

(col. 10, lines 6-14; col. 11, lines 3-14; col. 11, line 15 – col. 12, line 15; col. 13, line 66 –

col. 14, line 33).

As to claims 8, 9, 12-14, reference is made to a method that corresponds to the program product of claims 1, 2 and 5-7 and therefore is met by the rejection of claims 1, 2 and 5-7 above.

As to claims 15-17, 19 and 20, reference is made to a system that corresponds to the program product of claims 1, 2 and 5-7 and is therefore met by the rejection of claims 1, 2 and 5-7 above.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4.   Claims 3, 10 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over OKIMOTO (U.S. Patent 6,160,631) in view of SMITH (U.S. Patent 6,359,642).

As to claim 3, OKIMOTO substantially discloses the invention above. However, OKIMOTO does not teach the cited functionality. SMITH teaches the operation (user selection of the print command from the print dialog box) includes an occurrence of a particular condition, i.e. detection of an idle printer (wherein when a user selects the document for print, a pre-start signal is sent to the change printer from an idle mode to a print mode if printer is detected as being idle) (col. 4, lines 1-32; col. 5, line 45 – col. 6,

line 27). Therefore, it would be obvious to one skilled in the art to combine the

teachings of OKIMOTO with the teachings of SMITH in order to facilitate reduced print

output time.

As to claim 10, reference is made to a method that corresponds to the program

product of claim 3 and therefore is met by the rejection of claim 3 above.

As to claim 18, reference is made to a system that corresponds to the program

product of claim 3 and is therefore met by the rejection of claim 3 above.

5.   Claims 4, 11, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable

over OKIMOTO (U.S. Patent 6,160,631) in view of MITSUTAKE (U.S. Patent

6,240,460).

As to claim 4, OKIMOTO substantially discloses the invention above. However,

OKIMOTO does not teach the cited functionality. MITSUTAKE teaches the operation

includes an occurrence of a particular condition, i.e. the detection of bandwidth available

of a network connection (detecting bandwidth use for the transmitter and receiver) (col.

8, lines 1-7; col. 8, lines 47 – col. 9, line 67). Therefore, it would be obvious to one

skilled in the art to combine the teachings of OKIMOTO with the teachings of

MITSUTAKE in order to facilitate efficient bandwidth usage in performing a print service.

As to claim 11, reference is made to a method that corresponds to the program

product of claim 4 and therefore is met by the rejection of claim 4 above.

As to claim 18, reference is made to a system that corresponds to the program

product of claim 4 and is therefore met by the rejection of claim 4 above.

Response to Arguments

6.   Applicant's arguments filed 6/15/05 have been fully considered but they are not

persuasive.

Applicant states that the Okimoto reference appears to describe an intended

result that only comes to fruition after an initiation of the operation. In contrast,

Applicant's independent claims as amended recite "requesting that a user input delay

criteria before the initiation of the operation; and delaying performance by the computer

system of the operation until the delay criteria has been met." Applicant has also

alluded to the initiation by the computer of an operation as issuing print commands,

issuing mail transmission commands, instigating of a file transfer protocol upload, etc.

and that such initiation is delayed until the delay criteria has been satisfied. Applicant

argues that the Okimoto reference therefore does not describe or anticipate a user

inputs a delay criteria before the initiation of an operation, nor delaying performance by

the computer system of the operation until the delay criteria has been met (response,

pgs. 6-7). The examiner disagrees. The examiner agrees with Applicant that initiation

by the computer of an operation could be the **issuing** of print commands, **issuing** of

mail transmission commands, and **instigating** of a file transfer protocol upload,
however the interpretation of this limitation is not limited to these particular
embodiments. The claim language that Applicant used is "requesting that a user input
a delay criteria before the **initiation** of the operation...wherein the operation comprises
at least one operation chosen from the group consisting of a print command, an e-
mailing distribution, a software installation, a file transfer protocol upload, a web site
posting and an internet phone call. "Initiation" is defined as to cause or facilitate the
beginning of : set going. Initiation is not limited to the issuing or instigating of
instructions, but includes the actual start of instruction execution, hence in a print
command, the initial actual printing instructions. Okimoto teaches that a user enters via
a graphical user interface a delay criteria (date and time). The printer upon receiving
the instructions does not begin executing the print command (via output the data) until
the delay criteria is met (see column 6, lines 1-6, "...the print data included with the mail
can be outputted by the printer **at the indicated date and time**."). Hence, the printer
on the destination computer does not execute or initiate the execution of its print
command until the date and time as indicated have been met. Therefore, the teachings
of Okimoto meet the limitations as disclosed because the print data is not outputted and
thereby initiated until the date and time, as entered prior by the user, are met.

Applicant argues that the same reasoning in regards to the 103 rejection of
claims 3, 10, 18, 21, and 22. In response, the examiner refers to the arguments made
above in showing that Okimoto and therefore the combination adequately teaches the
limitations as disclosed and therefore the rejection is maintained.

Previously Cited Prior Art Relevant but Not Relied Upon

The following references where used in a prior communication wherein the claims alluded to the delay criteria being entered prior to the initiation of the operation:

Previously Cited U.S. Patent 6,567,176 (Jeyachandran) from Office Action mailed 3/15/04 teaches a user inputting delay criteria for a job, i.e. waiting until the printer is idle, and delaying the initiation / execution of the print operation until the printer is idle.

Previously Cited "OpenVMS User's Manual" by Digital Equipment Corporation, herein DEC, from Office Action mailed 3/15/04 teaches a user inputting a time delay for a snapshot of the screen to be taken and issued to be printed before the actual taking and printing of the snapshot (see page 5).

Conclusion

7.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of
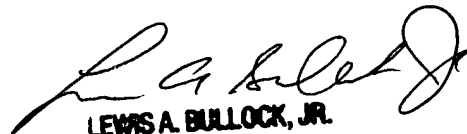
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lewis A. Bullock, Jr. whose telephone number is (571) 272-3759. The examiner can normally be reached on Monday-Friday, 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng An can be reached on (571) 272-3756. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LEWIS A. BULLOCK, JR.
PRIMARY EXAMINER

July 5, 2005